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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,178	10/17/2001	Jack Rogers	7570/73272	3914

7590 10/18/2004  
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EXAMINER

HAYES, ROBERT CLINTON

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/978,178

**Applicant(s)**

ROGERS, JACK

**Examiner**

Robert C. Hayes, Ph.D.

**Art Unit**

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 17-19, 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 20, 22, 23, 26, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 21 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                       |                                                                                        |
|-----------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____                                                |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed 7/26/04 has been entered.
2. The disclosure is objected to because of the following informalities: A reference to the prior application must be inserted as the **first sentence** of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). Appropriate correction is required.
3. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 because 37 CFR 1.821 (a)(2)(c-d) states that *each sequence disclosed must appear separately in the "Sequence listing" and in the text of the description and claims whenever described*. For example, the appropriate SEQ ID NOs must be recited in the figure legend for Figure 1 on page 4 of the specification.

Note that failure to respond to both the requirements for sequence compliance and the restriction requirement below will be held as *nonresponsive*, and may result in *abandonment* of this application.

4. The rejection of claim 12 under 35 U.S.C. 112, second paragraph, as being indefinite and/or incomplete is withdrawn due to the amendment and cancellation of the claims.

5. Applicants' arguments filed 7/26/04 have been considered but were not found persuasive.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 17-19, 24 & 25 are allowed.

Note that because SEQ ID NO: 17 is 23 amino acid residues, claim 18 is therefore limited to SEQ ID NO: 23 (i.e., as it relates to what "consisting essentially" now encompasses). Note further that because Applicant may claim inventions in multiple ways, claim 18 is not being objected to under 37 CFR 1.75 as being a substantial duplicate of claim 24. See *Tandon Corp. v. United States Int'l Trade Comm.* 4 USPQ 1283 (Fed. Cir. 1987).

8. Claims 28-29 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 28 & 29 have not been further treated on the merits.

9. Claims 23 & 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No proper antecedent basis nor conception in context with that describe within the specification at the time of filing Applicant's invention exists for the broader conception of any type of undefined treatment "wherein said pharmaceutical composition *is indicated for use in the treatment of* stroke, heart attack, spinal injury, or *for administration to* a patient before surgery". In contrast, page 4 of the specification contemplates "*for reducing oxidation-related damage* in a patient suffering from a stroke...", or "administered... prior to a patient undergoing surgery to *reduce cellular injury resulting from oxidative stress*"; thereby, constituting new matter.

10. Claims 20, 22, 26 & 28-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite and incomplete for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for similar reasons made of record for cancelled claims 7 & 12 in Paper No: 20040505.

Similar to that previously made of record, the recitation of "in unit dosage form comprising a *therapeutically effective amount*" is indefinite, because the metes and bounds are not defined because no disease state, dosage, etc. is recited in the claims, in order to determine what "*therapeutically effective amount*" / dosage is envisioned, etc. Again, note that the sentence bridging pages 7-8 states that "this will vary depending upon clinical conditions...". For example, see previous paragraph for possible acceptable claim language to obviate this rejection. It is noted that Applicant chose to ignore the Examiner's previous suggestions for claim amendments.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (571) 272-0885. The examiner can normally be reached on Monday through Thursday, and alternate Fridays, from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert C. Hayes, Ph.D.  
October 12, 2004

**ROBERT C. HAYES, PH.D.**  
**PATENT EXAMINER**

  
**BRENDA BRUMBACK**

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